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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,116	12/05/2003	Gregory W. Schad	DU-041-US-01	3190
7590 08/11/2004			EXAMINER	
H.B. Fuller, Patent Department 1200 Willow Lake Blvd. P.O. Box 64683 St. Paul, MN 55164-0683			REDDICK, MARIE L	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,116	SCHAD ET AL.	
	Examiner	Art Unit	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/05/03;02/17/04;03/29/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 02/17/04 has been considered and scanned into the application file.

Specification

2. The disclosure is objected to because of the following informalities: On page 6 @ line 10 the U.S. Serial no. is missing for the copending patent application.

Appropriate correction is required.

3. The use of the trademarks at least "RhoXimat"(page 4, line 36), "Hybridur", "NeoPac"(page 5, line 25), "Nyad", "Wollastocoat", "Roxul", Arbocel"(page 6, lines 15, 16 & 18) and also pages 7-19, Runs inclusive, has been noted in this application. It should be **capitalized** wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "substantially water resistant" per claim 1 constitutes indefinite subject matter as per the metes and bounds of "substantially" engender indeterminacy in

scope. The term “substantially” is relative and not absolute. Furthermore, said term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There are two separate requirements set forth in the § 112, second paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

See M.P.E.P. § 2171.

B) The recited “modified acrylic latex” per claim 3 constitutes indefinite subject matter as per the metes and bounds of the term “modified” engenders indeterminacy in scope. See § A) supra for more details.

C) The recited “substantially stain resistant” per claim 14 constitutes indefinite subject matter as per the metes and bounds of “substantially” engender scope indeterminacy. See § A) supra for further details.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: As far as the Examiner can readily ascertain, proper antecedent basis has not been provided for “a silanated polymer in an amount effective to render the dried grout composition substantially water resistant” per claim 1, “modified acrylic latex” per claim 3 and “wherein the fiber fillers are provided in an amount of at least about 25 wt %” per claim 12.

Claim Objections

7. Claim 11 objected to because of the following informalities: In claim 11 @ line 2, it is suggested that the term “composition” be inserted after “grout” so as to maintain claim language consistency. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price(U.S. 2,821,521).

Price teaches the use of acrylonitrile copolymers, in latex form, as a component of a coating composition and as an equivalently identified one-part grouting composition additive. Price teaches that the acrylonitrile copolymers can be formed by the copolymerization, in emulsion, of N-substituted maleamic acid, acrylonitrile and other

comonomers such as styrene, allyl trichlorosilane, tetraallyl silane, tetraallyl silicate, hexallyl disiloxane etc. Price further teaches that the copolymers can be used with a filler or other additives such as various fibers, etc. See. Col. 1, lines 15-64, col. 2, lines 10-72, col. 3, lines 1-75, col. 4, lines 1-49, col. 5, lines 46-47, col. 10, lines 70-71, the paragraph bridging cols 12 & 13, col. 13, lines 24-25.

The disclosure of Price differs basically from the claimed invention as per the non-specific disclosure of an embodiment directed to the use of the specifically defined copolymer, as a component in a grouting composition. However, one having ordinary skill in the art would have found it obvious to select a silane monomer and a silane/styrene monomer combination in forming the acrylonitrile copolymer(silanated) for use as a grouting composition additive in the scheme of Price as per such having been within the purview of the general disclosure of Price and with a reasonable expectation of success. It is well established that a reference is available for all it teaches including nonpreferred embodiments as for instance is discussed in M.P.E.P. § 2123 which is quoted in its entirety below (underlinings added).

2123 Rejection Over Prior Art's Broad Disclosure Instead of Preferred Embodiments

PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other

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product for the same use.” In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have “relatively acceptable dimensional stability” and “some degree of flexibility,” but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that applicant’s argument that the reference teaches away from using epoxy was insufficient to overcome the rejection since “Gurley asserted no discovery beyond what was known in the art.” 27 F.3d at 554, 31 USPQ2d at 1132.).

As to the content of silanated polymer, in latex form, (5-7) and fiber fillers (12 and 13), although the disclosure of Price is generic thereto, such is a necessary implication that any contents, including the claimed contents, would have been operable within the scope of patentees invention and with a reasonable expectation of success. In as much as the amounts of these components appear to be nothing other than conventional amounts used in forming a suitable grout composition, one having ordinary skill in the art, via mere routine experimentation, could readily determine the amounts suitable for use in forming the grouting composition. It would have been within the routine skill in the art to figure out those amounts needed to meet a grout composition falling within the scope of the claimed invention. Criticality for such, commensurate in scope with the claims, not having been demonstrated on this record.

As to the claimed property limitations, it is tenable that these properties may be met by the grouting composition of Price, as modified supra, since the modified grouting composition of Price is essentially the same as the claimed grout composition. The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the

suggestion of the prior art.). See also *Lantech Inc. v. Kaufman Co. of Ohio Inc.*, 878 F.2d 1446, 12 USPQ2d 1076, 1077 (Fed. Cir. 1989), cert. denied, 493 U.S. 1058 (1990) (unpublished — not citable as precedent) (“The recitation of an additional advantage associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention.”). See M.P.E.P. § 2145 II.

As to any remaining dependent claims, the limitations, if not taught or suggested, would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

Claim Rejections - 35 USC § 103

12. Claims 1, 8, 9, 10 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frazza et al (U.S. 3,001,974).

Frazza et al teach the use of acrylonitrile copolymers derived from a beta-cyanovinylamine and other comonomers such as allyl trichlorosilane, diallyl dichlorosilane, tetraallyl silane, tetraallyl silicate and hexallyl disiloxane in forming grouting compositions (cols. 1-5, especially the paragraph bridging cols. 3 and 4, col. 11, lines 1-75 and col. 13, lines 1 and 2).

The disclosure of Frazza et al differs basically from the claimed invention as per the non-specific disclosure of an embodiment directed to the use of the specifically defined copolymer, as a component in a grouting composition. However, one having ordinary skill in the art would have found it obvious to extrapolate a silanated polymer, as claimed, from Frazza et al as per such having been within the purview of the general disclosure of Frazza et al and with a reasonable expectation of success. It is well established that a reference is available for all it teaches including nonpreferred embodiments as for

instance is discussed in M.P.E.P. § 2123 which is quoted in its entirety below
(underlinings added).

2123 Rejection Over Prior Art's Broad Disclosure Instead of Preferred Embodiments

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Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have "relatively acceptable dimensional stability" and "some degree of flexibility," but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that applicant's argument that the reference teaches away from using epoxy was insufficient to overcome the rejection since "Gurley asserted no discovery beyond what was known in the art." 27 F.3d at 554, 31 USPQ2d at 1132.).

As to the claimed properties, it is tenable that these properties may be met by the grouting composition of Frazza et al, as modified supra, since the modified grouting composition of Frazza et al is essentially the same as the claimed grout composition. The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth

heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.). See also *Lantech Inc. v. Kaufman Co. of Ohio Inc.*, 878 F.2d 1446, 12 USPQ2d 1076, 1077 (Fed. Cir. 1989), cert. denied, 493 U.S. 1058 (1990) (unpublished — not citable as precedent) ("The recitation of an additional advantage associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention."). See M.P.E.P. § 2145 II.

As to any remaining dependent claims, the limitations, if not taught or suggested, would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/729,630. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed one-part polymer grout composition of copending Application'630 overlaps in scope with the claimed one-part polymer grout composition. The properties of the instantly claimed grout composition would be expected to be

possessed by the grout composition of U.S.'630, as claimed since the claimed grout compositions overlap in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

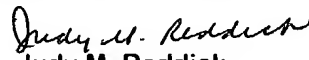
Conclusion


15. The additional prior art, listed on the attached PTO FORM 892, is cited as of interest in teaching compositions similar to those as claimed and is considered merely cumulative to the prior art *supra*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
08/08/04